

**UNITED STATES DEPARTMENT OF COMMERCE****United States Patent and Trademark Office**

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*John*

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/117,838	08/12/98	EPHSTEIN	0

<input type="checkbox"/>	ILYA ZBOROVSKY 6 SCHOOLHOUSE WAY DIX HILLS, NY 11746	HM12/0502	<input type="checkbox"/>	EXAMINER	OWENS JR, H
				ART UNIT	PAPER NUMBER
				1623	<i>13</i>
				DATE MAILED:	05/02/01

Please find below and/or attached an Office communication concerning this application or proceeding.

**Commissioner of Patents and Trademarks**

## Office Action Summary

Application No.  
09/117,838

Applicant(s)

Epshtein

Examiner

Howard Owens

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

1)  Responsive to communication(s) filed on Feb 20, 2001

2a)  This action is FINAL. 2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

### Disposition of Claims

4)  Claim(s) 9-12 is/are pending in the application.

4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 9-12 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

11)  The proposed drawing correction filed on \_\_\_\_\_ is: a)  approved b)  disapproved.

12)  The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119

13)  Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a)  All b)  Some\* c)  None of:

- Certified copies of the priority documents have been received.
- Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
- Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

14)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

### Attachment(s)

15)  Notice of References Cited (PTO-892)

16)  Notice of Draftsperson's Patent Drawing Review (PTO-948)

17)  Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_

18)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_

19)  Notice of Informal Patent Application (PTO-152)

20)  Other: \_\_\_\_\_

Detailed Action

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This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

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Specification

Objection to the abstract is maintained. The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 250 words. The abstract also appears to contain the misspelled word "homeopathis".

Claim Objections

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Claim 9 appears to contain the misspelled term "doze". Appropriate correction is required for this and any other typographical or spelling errors not noted herein should be corrected.

The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

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Misnumbered claims 5 - 8 been renumbered 9 -12.

**Claim Rejections - 35 U.S.C. § 112**

5 The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10 Claims 9-12 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In the absence of a structural formula or chemical name, the following terms are seen to render the claims in which they appear indefinite in all occurrences: medicinal substance and medicinal preparation.

15 In claims 9 and 10, applicant recites a method of making a medicinal substance which is produced by homeopathic methods and has initial a chemical formula or composition identical with that of the said active substance. It is unclear as to how a compound that has the "identical" chemical formula as the active substance can be differentiated from the active substance and is not the active substance itself as products of identical chemical composition can not have mutually exclusive properties.

20 It is also unclear as to what the term "biologically" means. Moreover, it is unclear what the terms "biologically transferring information" mean within the context of the instant invention, specifically what is the actual medicinal substance and through what means, a mechanical device or the action of mixing, is the transfer of "information" accomplished between the potentiated substance and the material carrier/active substance. If applicant asserts that the biologically transferred information is the active medicinal substance it further becomes unclear as to what this unidentified

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"information" is chemically or structurally and how it is differentiated from the undefined potentiated medical substance.

**Claim Rejections - 35 U.S.C. § 102**

5 The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

10 (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 11 and 12 are rejected under 35 U.S.C. § 102(b) as being anticipated by Ecanow, U.S. Patent No. 4,963,367.

15 Claims 11 and 12 are drawn to a medicinal preparation comprising an active medicinal substance in therapeutic dose and a potentiated homeopathic medicinal substance having a same chemical formula or composition as said active medicinal substance. Applicants inclusion of a process step wherefrom the medicinal substance is derived is not seen as relevant within the instant composition claims. The patentability in composition claims resides in the compound(s) thereof, no matter what 20 method of production is set forth. A compound that has the "identical" chemical formula as the active substance can not be differentiated from the active substance. The open claim language also allows for the addition of common or suitable excipients or carriers. As such, applicant has made a claim to any compound of therapeutic nature. Ecanow anticipates these claims as it discloses a medicinal preparation comprising a material 25 carrier and one or more active compounds dispersed in an aqueous solution (see claim 5 and p.1-3).

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Howard Owens whose telephone number is (703) 306-4538 . The examiner can normally be reached on Mon.-Fri. from 8:30 a.m. to 5 p.m.

5 If attempts to reach the examiner by telephone are unsuccessful, the Primary Examiner signing this action, Gary Geist, can be reached on (703) 308-1701 . The fax phone number for this Group is (703) 308-4224.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.

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Howard Owens

Group 1623



GARY GEIST  
SUPERVISORY PATENT EXAMINER  
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